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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,870	02/27/2004	Vadim Fux	55525501.2558	7232
89441	7590	03/19/2010		
Jones Day (RIM) - 2N North Point 901 Lakeside Avenue Cleveland, OH 44114			EXAMINER PATEL, MANGLESH M	
			ART UNIT 2178	PAPER NUMBER
			NOTIFICATION DATE 03/19/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/788,870

**Applicant(s)**

FUX ET AL.

**Examiner**

MANGLES M. PATEL

**Art Unit**

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/8/2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24 and 26-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24 and 26-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/22)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION**

1. This **Non-Final** action is responsive to the pre-appeal decision mailed 1/8/2010 (prosecution has been reopened).
2. Claims 24 and 26-42 remain pending. Claims 24, 31, 34 and 40 are the independent claims.

**Withdrawn Rejections**

3. The 35 U.S.C. 103(a) rejections of claims 24 and 26-42 with cited references Matsumoto (U.S. 7,373,140) in view of Flowers (U.S. 5,533,174) has been withdrawn in light of the persuasive arguments.

**Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 24 and 26-42 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Shiimori (U.S. 7,010,587, filed Aug. 21, 2000, previously cited in the action dated 2/27/2009).

**Regarding Independent claim 24**, Shiimori discloses A method performed by a server, comprising: (i) storing a client profile, the client profile comprising a font capabilities list for each of multiple client devices, each font capabilities list comprising a list of fonts for which the device has font structure data, the font structure data defining the structure in which text formatted with the respective font is to be rendered (see abstract & fig 10 & column 4, lines 16-67, disclosing a font capabilities list for each of multiple client devices and respective OS); (ii) receiving text data addressed to a designated one of the devices, the text data comprising text and font identifiers, the font identifiers identifying which fonts to use to render the text (fig 10, numeral 92, disclosing receiving text data that includes text and font identifiers such as the font name based on the determined service); (iii) comparing the font identifiers in the text data with the fonts in the capabilities list of the designated device, to determine the font identifiers for which the designated device lacks font structure data (see fig 10 numeral 92 where a search is performed for font file associated with the requested service which includes the needed font); (iv) transferring the lacking font structure data and the text data to the designated device, wherein the device stores the received font structure data in the client device; and (v)

updating the client profile with the stored font structure data (see column 4, lines 56-67 & column 5, lines 1-15, wherein the lacking font structure and text is transferred to the device, stored and then displayed. The font files are then updated at the server). The font are determined based on the requested service type not on requested text information. However at the time of the invention it would have been obvious to include web page requests as a service for translating fonts. The motivation for doing so would have been to properly display text in the appropriate fonts on a limited display device.

**Regarding Dependent claim 26**, with dependency of claim 24, Shiimori discloses the server receives the text data along with attendant font structure data required to render the text data, and, in step iv, the server operatively refrains from transferring the attendant font structure data to the device in response to determining in the comparing step that the device already has the attendant font structure data (column 4, lines 56-67 & column 5, lines 1-15, wherein the server refrains from transferring font data already supported in the font list).

**Regarding Dependent claim 27**, with dependency of claim 24, Shiimori discloses requesting and receiving the lacking font structure data from a third part server (see abstract disclosing receiving lacking font structure from a server).

**Regarding Dependent claim 28**, with dependency of claim 24, Shiimori discloses Determining whether any of the font identifiers in the received text data that are not found in the font capabilities list of the designated device have equivalent counterparts that are found in the font capabilities list of the designated device (column 4, lines 56-67 & column 5, lines 1-15).

**Regarding Dependent claims 29, 32, 38 and 41**, with dependency of claim 24, Shiimori discloses further comprising a step, performed before step (i), of receiving a list of client font capabilities from each of the client devices (see figs 3 & 5, wherein a list of client font capabilities from each client device is received).

**Regarding Dependent claims 30, 33, 39 and 42**, Shiimori discloses wherein the client devices are wireless mobile communication devices (see column 3, lines 25-60).

**Regarding Independent claim 31**, Shiimori discloses A method comprising the following steps performed by a server in the following order: (i) storing a client profile, the client profile comprising a font capabilities list for each of

multiple client devices, each font capabilities list comprising a list of fonts for which the device has font structure data, the font structure data defining the structure in which text formatted with the respective font is to be rendered (see abstract & fig 10 & column 4, lines 16-67, disclosing a font capabilities list for each of multiple client devices and respective OS); (ii) receiving text data addressed to a designated one of the devices, the text data comprising text and font structure data for rendering the text (fig 10, numeral 92, disclosing receiving text data that includes text and font identifiers such as the font name based on the determined service); (iii) determining, from the stored capabilities list for the designated device, whether the device already has the font structure data (see fig 10 numeral 92 where a search is performed for font file associated with the requested service which includes the needed font); and (iv) transferring the text to the device, and operatively refraining from transferring the font structure data to the device in response to determining, in step iii, that the device already has the font structure data (see column 4, lines 56-67 & column 5, lines 1-15, wherein the lacking font structure and text is transferred to the device, stored and then displayed. The font files are then updated at the server). The font are determined based on the requested service type not on requested text information. However at the time of the invention it would have been obvious to include web page requests as a service for translating fonts. The motivation for doing so would have been to properly display text in the appropriate fonts on a limited display device.

**Regarding Independent claim 34,** Shimori discloses A method comprising the following steps performed by a server in the following order: (i) storing a client profile, the client profile comprising a font capabilities list for each of multiple client devices, each font capabilities list comprising a list of fonts for which the device has font structure data, the font structure data defining the structure in which text formatted with the respective font is to be rendered (see abstract & fig 10 & column 4, lines 16-67, disclosing a font capabilities list for each of multiple client devices and respective OS); (ii) receiving text data addressed to a designated one of the devices, the text data comprising text and font identifiers, the font identifiers identifying which fonts to use to render the text (fig 10, numeral 92, disclosing receiving text data that includes text and font identifiers such as the font name based on the determined service); (iii) determining which of the text data's font identifiers is not found in the designated device's font capabilities list (see fig 10 numeral 92 where a search is performed for font file associated with the requested service which includes the needed font); (iv) determining whether another font identifier exists that is the same as said not found font identifier; and (v) transferring the text data to the designated device (see column 4, lines 56-67 & column 5, lines 1-15, wherein the lacking font structure and text is transferred to the device, stored and then displayed. The font files are then updated at the server). The font are determined based on the requested service type not on requested text information.

However at the time of the invention it would have been obvious to include web page requests as a service for translating fonts. The motivation for doing so would have been to properly display text in the appropriate fonts on a limited display device.

**Regarding Dependent claim 35**, with dependency of claim 34, Shiimori discloses wherein step iv includes determining whether another font identifier exists in the designated font capabilities list that is the same as said not found font identifier (see fig 3, wherein other font identifiers are determined in the capabilities list).

**Regarding Dependent claim 36**, with dependency of claim 34, Shiimori discloses wherein step iv includes determining whether the server has font structure data for said another font identifier, and step V includes transferring said font structure data for said another font identifier to the designated device (see fig 3 & 10).

**Regarding Dependent claim 37**, with dependency of claim 34, Shiimori discloses wherein step iv includes determining whether another server has font structure data for said another font identifier, and obtaining said font structure data from said other server, and step v includes transferring said font structure data for said another font identifier to the designated device (see abstract & fig 10, wherein font data is obtained from another server).

**Regarding Independent claim 40**, Shiimori discloses A method comprising the following steps performed by a server in the following order: (i) storing a font capabilities list for each of multiple client devices, each font capabilities list comprising a list of fonts for which the device has font structure data, the font structure data defining the structure in which text formatted with the respective font is to be rendered (see abstract & fig 10 & column 4, lines 16-67, disclosing a font capabilities list for each of multiple client devices and respective OS); (ii) receiving text data addressed to a designated one of the devices, the text data comprising text and font identifiers, the font identifiers identifying which fonts to use to render the text (fig 10, numeral 92, disclosing receiving text data that includes text and font identifiers such as the font name based on the determined service); (iii) determining which of the text data's font identifiers is not found in the designated device's font capabilities list (see fig 10 numeral 92 where a search is performed for font file associated with the requested service which includes the needed font); (iv) requesting and receiving font structure data for said not found font identifier from another server (see column 4, lines 56-67 & column 5, lines 1-15, wherein the lacking font structure and text is transferred to the device, stored and then displayed. The font files are then updated at the server); and (v) transferring both the text data and the font structure data for said not found

font identifier to the designated device (see column 5, lines 1-30, wherein the text and font structure data is transferred for display to the client device). The font are determined based on the requested service type not on requested text information. However at the time of the invention it would have been obvious to include web page requests as a service for translating fonts. The motivation for doing so would have been to properly display text in the appropriate fonts on a limited display device.

**It is noted that any citation [[s]] to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. [[See, MPEP 2123]]**

#### **Response to Arguments**

6. Applicant's arguments filed 12/11/2009 have been fully considered but are moot in view of the new grounds of rejection.

#### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manglesh M. Patel whose telephone number is (571) 272-5937. The examiner can normally be reached on M, W 6 am-3 pm T, TH 6 am-2pm, Fr 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/788,870

Page 7

Art Unit: 2178

Manglesh M. Patel  
Patent Examiner  
March 12, 2010

/Manglesh M Patel/  
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Examiner, Art Unit 2178

/Stephen S. Hong/

Supervisory Patent Examiner, Art Unit 2178